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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/785,842      | 02/16/2001  | Calvin Joseph Stowe II | 154-23110-US        | 3585             |

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EXAMINER

TUCKER, PHILIP C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1712

DATE MAILED: 09/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

785842

Applicant(s)

STOWE

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 - 38 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 19 is/are allowed.
- ☒ Claim(s) 1 - 12, 14 - 18, 20 - 31, 33 - 38 is/are rejected.
- ☒ Claim(s) 13, 32 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,6
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, there is no antecedent basis for "the saturated salt brine" therein, or in the parent claims.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Applicants specification fails to teach that ether carboxylates are precipitating agents.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-12, 14, 16-18, 20-31 and 33-37 are rejected under 35 U.S.C. 102(a or e) as being anticipated by GB 2351986.

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GB 2351986 teaches a drilling fluid, for drilling a wellbore, which comprises a latex, water, a surfactant, salts (page 9) and a silicate or alumino-silicates (clays), which are the same as the precipitating agent of the present invention (see page 5, line 23 and claims). Although, GB '986 does not specifically state that the silicate or clay is a precipitating agent, the mere reason for adding a material to another is not a patentable difference (In re Lintner 173 USPQ 356, In re Mod 168 USPQ 281). The present invention is thus anticipated by GB 2351986.

7. Claims 1-5, 7-9, 11, 12, 14, 15, 20-24, 26, 27, 28, 30, 31, 33, 34 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2131067.

GB 2131067 teaches a drilling fluid, for drilling a wellbore, which comprises a latex, water, a surfactant and bentonite which is an alumino-silicate, which is the same as the precipitating agent of the present invention (see claims). Although, GB '067 does not specifically state that the clay is a precipitating agent, the mere reason for adding a material to another is not a patentable difference (In re Lintner 173 USPQ 356, In re Mod 168 USPQ 281). The present invention is thus anticipated by GB '067.

8. Claims 1-5, 7-9, 11, 12, 14-18, 20-28, 30, 31, 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Griffith (6401817).

Griffith teaches a drilling fluid, for drilling a wellbore, which comprises a latex, such as polyisoprene, water, sodium carbonate salt, a surfactant and bentonite which is an alumino-

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silicates, which is the same as the precipitating agent of the present invention (see examples, column 5, lines 3-20, column 4, lines 11-24 and claims). Although, Griffith does not specifically state that the clay is a precipitating agent, the mere reason for adding a material to another is not a patentable difference (In re Lintner 173 USPQ 356, In re Mod 168 USPQ 281). The present invention is thus anticipated by GB '067.

9. Claims 13 and 32 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 19 is allowable over the art of record.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2633  
September 9, 2002

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**